

07/954,646 09/30/92



UNITED STATES DEPARTMENT OF COMMERCE
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 SPIEGEL, C

18M1/0408

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|-------------------------|----------------|----------|-----------------------|---------------------|
| SERIAL NUMBER | FILED AND DATE | INVENTOR | FIRST NAMED APPLICANT | ATTORNEY DOCKET NO. |
| STUART STREET TOWER | | | | |
| ONE MARKET PLAZA | | | | |
| SAN FRANCISCO, CA 94105 | | | | |

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| 1802 | |
| EXAMINER | |
| 04/08/94 | |
| ART UNIT | PAPER NUMBER |
| | 15 |

DATE MAILED:

Below is a communication from the EXAMINER in charge of this application

COMMISSIONER OF PATENTS AND TRADEMARKS

ADVISORY ACTION

☒ THE PERIOD FOR RESPONSE:

- a) ☒ is extended to run _____ or continues to run 3 mos from the date of the final rejection
- b) ☐ expires three months from the date of the final rejection or as of the mailing date of this Advisory Action, whichever is later. In no event however, will the statutory period for the response expire later than six months from the date of the final rejection.
- Any extension of time must be obtained by filing a petition under 37 CFR 1.136(a), the proposed response and the appropriate fee. The date on which the response, the petition, and the fee have been filed is the date of the response and also the date for the purposes of determining the period of extension and the corresponding amount of the fee. Any extension fee pursuant to 37 CFR 1.17 will be calculated from the date of the originally set shortened statutory period for response or as set forth in b) above.

☐ Appellant's Brief is due in accordance with 37 CFR 1.192(a).☒ Applicant's response to the final rejection, filed 3/9/94 has been considered with the following effect, but it is not deemed to place the application in condition for allowance:

1. ☐ The proposed amendments to the claim and/or specification will not be entered and the final rejection stands because:
- ☐ There is no convincing showing under 37 CFR 1.116(b) why the proposed amendment is necessary and was not earlier presented.
 - ☐ They raise new issues that would require further consideration and/or search. (See Note).
 - ☐ They raise the issue of new matter. (See Note).
 - ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal.
 - ☐ They present additional claims without cancelling a corresponding number of finally rejected claims.

NOTE:

2. ☐ Newly proposed or amended claims _____ would be allowed if submitted in a separately filed amendment cancelling the non-allowable claims.

3. ☒ Upon the filing an appeal, the proposed amendment ☒ will be entered ☐ will not be entered and the status of the claims will be as follows:

Claims allowed: 105, 107-108, 120Claims objected to: NONEClaims rejected: 109-115, 117-119

However;

☒ Applicant's response has overcome the following rejection(s): IN THE FINAL OFFICE ACTION MAILED 35 USC 112 second and fourth paragraphs. However, see attached for new rejection's under 35 USC 112, ¶ 2.

4. ☐ The affidavit, exhibit or request for reconsideration has been considered but does not overcome the rejection because _____

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Upon the filing of an appeal, the proposed amendment after final rejection filed March 9, 1994 (paper #13) will be entered as it overcomes some of the outstanding rejections. However, the proposed amendment creates new issues under 35 U.S.C. § 112, ¶2 and fails to address an outstanding issue under 35 U.S.C. § 112, ¶1.

The new issues are ones of antecedent basis created by the proposed amendments. Specifically,

in claim 109, line 3 "said oligonucleotides" should now read --said groups of oligonucleotides--;

in claim 110, line 2, "oligonucleotides" should now read --groups of oligonucleotides-- and line 4 should insert --said-- before "predefined;

in claim 112, line 3 "oligonucleotides" should now read --groups of oligonucleotides--;

in claim 113, line 3 "oligonucleotides" should now read --groups of oligonucleotides--;

in claim 114, line 2, "oligonucleotides" should now read -- groups of oligonucleotides--;

in claim 115, line 2, "the oligonucleotides" should now read --the groups of oligonucleotides--; and,

in claim 119, line 2 "oligonucleotides" should now read --groups of oligonucleotides--.

The outstanding issue under 35 U.S.C. § 112, ¶ 1 is that claims 109, 114 and 117-119 are only enabled for substrates produced by light directed photolithographic synthesis using a matrix mask strategy (see paper 12, p.3, 1.6-20). Applicants' position, as stated in a telephone message April 4, 1994, is that these claims are directed to a substrate, not to a method of fabricating the substrate. Therefore, this rejection is not applicable. This argument is not persuasive because, as evident from the withdrawn rejections over the prior art, these claims are directed to substrates of unexpectedly

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dense groupings of known, different oligonucleotide sequences in the recited areal dimensions. The specification only discloses a single critical method for the production of these substrates. Therefore, it is respectfully submitted that this rejection is proper. Ex parte Jochim, 11 USPQ2d 1561 (Bd. of Patent Appeals and Interferences 1989).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Carol A. Spiegel whose telephone number is (703) 308-3986.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0196.

Carol A. Spiegel
April 6, 1994


ESTHER M. KEPPLINGER
SUPERVISORY PATENT EXAMINER
GROUP 1800